

PATENT

**C. REMARKS**

Claims 1-2, 4-16, and 18-28 are pending in the present application. Claims 1, 8, 15, 22-23, and 25 have been amended. Claims 3 and 17 have been cancelled. Claims 26-28 are newly added. Reconsideration of the claims is respectfully requested.

Applicants wish to thank the Examiner for his courtesy in allowing Applicants a telephonic interview on March 30, 2005. During the interview, the claim rejections under 35 U.S.C. § 112, ¶1 and 35 U.S.C. §§ 102, 103 were discussed, as set forth below.

**I. Drawing Objection**

The Examiner objected to Figure 15 for labeling element 1590 as "Element Request," rather than "Element Response," as in the text of the specification. In response to the Examiner's objection, Applicants have amended Figure 15 to label element 1590 as "Element Response." A replacement sheet incorporating the amendment was included with the Response filed on April 13, 2005. Applicants therefore respectfully request that the objection be withdrawn.

**II. 35 U.S.C. § 112, ¶1: Written Description**

The Examiner rejected claims 3, 17, 22, and 25 under 35 U.S.C. § 112, ¶1 for failing to comply with the written description requirement. This rejection is respectfully traversed.

As discussed during Applicants' telephone interview with the Examiner on March 30, 2005, the rejection of claims 3, 17, 22, and 25 was due to an apparent failure to provide antecedent basis for the term "retrieved name," since claims 1, 15, 22, and 25 recited both a "non-instance name" and an "instance name," either of which might have been a "retrieved name." As agreed to in the interview, Applicants have amended claims 1, 15, 22, and 25 to instead introduce a single term ("retrieving a *name* . . ."), then qualify that term as being either a "non-instance name" or an "instance name" according to the circumstances (the two possibilities being mutually exclusive).

Because the Examiner indicated that such an amendment would overcome the rejection under 35 U.S.C. § 112, ¶1, Applicants respectfully request that the rejection be withdrawn, as agreed.

Docket No. RSW920010051US1

Page 13 of 19  
Barker et al. - 10/047,784

Atty Ref. No. IBM-R111

## PATENT

III. 35 U.S.C. § 102: Anticipation

The Examiner rejected claims 1, 2, 5-9, 12-16, 19-21, and 23 under 35 U.S.C. § 102 as being anticipated by "WBEM on Sun Developer's Guide" by Sun Microsystems, Inc. (hereinafter "Sun WBEM"). Because Applicants have amended independent claims 1, 8, 15, and 23 to contain the subject matter of dependent claims 3 and 17, which were not rejected under 35 U.S.C. § 102, Applicants respectfully submit that the rejection of independent claims 1, 15, and 23 under 35 U.S.C. § 102 has been obviated, subject to the Examiner's rejection of claims 3 and 17 under 35 U.S.C. § 103, as discussed below. Since claims 2, 5-7, 9, 12-14, 16, and 19-21 are dependent claims that depend from independent claims 1, 8, and 15, the rejection under 35 U.S.C. § 102 has been obviated for those claims as well.

IV. 35 U.S.C. § 103: Obviousness

The Examiner rejected claims 3, 4, 10, 11, 17, 18, 22, 24, and 25 under 35 U.S.C. § 103 as being obvious in view of Sun WBEM and US 5,635,918 (TETT) 1997-6-3. Since Applicants have amended the claims to place the limitations of claims 3 and 17 into independent claims 1, 8, 15, and 23 and have cancelled claims 3 and 17, Applicants now understand the Examiner's obviousness rejection to pertain to claims 1-2, 4-16, and 18-25. The rejection is respectfully traversed.

With respect to claim 3, the rejection of which is representative of the rejections of the other claims, the Examiner stated:

In regard to claim 3, the above rejection of claim 1 is incorporated. Sun WBEM further discloses: *locating a qualifier corresponding to the retrieved name; reading a qualifier value corresponding to the qualifier*. See page 44: "Qualifiers Dialog Box". Sun WBEM does not expressly disclose replacing a retrieved name with the qualifier value. However, in an analogous environment, TETT teaches replacing one string, or name, with another. See column 4 lines 40-67. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use TETT's teaching of string replacement with Sun WBEM's name retrieval. One of ordinary skill would have been motivated to provide a string in the native language of a user (TETT column 2 lines 22-24) so that a user would be able to easily understand it. [Office Action, January 14, 2005, p.7].

A. Burden

The Office bears the burden of establishing a *prima facie* case of obviousness based on the prior art when rejecting claims under 35 U.S.C. § 103. *In re Fritch*, 972 F.2d 1260, 23 Docket No. RSW920010051US1

Page 14 of 19  
Barker et al. - 10/047,784

Atty Ref. No. IBM-R111

## PATENT

U.S.P.Q.2d 1780 (Fed. Cir. 1992). The Examiner has failed to meet that burden for the following reasons.

B. References must teach or suggest all elements of the rejected claims

For an invention to be *prima facie* obvious, the prior art must teach or suggest all claim limitations. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). “All words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

With regard to independent claims 1, 8, 15, and 22-25, the references fail to teach or suggest all elements of these claims. These independent claims all recite replacing *a retrieved name* with a *qualifier value*. Independent claim 1, representative of the other rejected claims, is reproduced below, with the pertinent parts highlighted in boldface for emphasis:

Claim 1 (currently amended): A method of generating display names for management definition data elements, said method comprising:

receiving an element identifier;

**retrieving a name from a management data definition**, wherein the retrieved name is a non-instance name if it is determined that an element corresponding to the element identifier is a non-instance element and wherein the retrieved name is an instance name if it is determined that the element corresponding to the element identifier is an instance element;

displaying the retrieved name on a display device;

locating a qualifier corresponding to the retrieved name;

reading a qualifier value corresponding to the qualifier; and

**replacing the retrieved name with the qualifier value prior to the displaying.**

Neither Sub WBEM nor TETT teach or suggest this feature. While the Examiner cites TETT as teaching “replacing one string, or name, with another” [Office Action, January 14, 2005, at 7], Applicants’ claim language is not as general as simply replacing one string with another. Applicants claim replacing a *retrieved name* (*i.e.*, a name retrieved from a management data definition, as in the second element of claim 1) with a *qualifier value*. As the Federal Circuit has stated, all limitations of the claimed invention must be considered when determining patentability. *In re Lowry*, 32 F.3d 1579, 1582, 32 U.S.P.Q.2d 1031, 1034 (Fed. Cir. 1994).

## PATENT

As it turns out, TETT does not teach or suggest replacing a retrieved name with a qualifier value. TETT teaches a technique of receiving a text message containing condensed content in a wireless receiver and expanding the message into a full-text version once the message is received:

A method and apparatus for controlling message delivery to wireless receiver devices can be used for example to condense textual messages intended for a wireless receiver device by abbreviating various words in the message. Thus, a first message addressed to a wireless receiver device (20) is received and stored in a storage medium (14). The received message is then translated into a second message using a pre-defined dictionary associated with the wireless receiver device. The second message is then sent to the wireless receiver device. Thus, the wireless receiver device receives shorter messages conveying the same information as the original message that was to be sent to the wireless receiver device. The translating feature can also be used to code messages or translate messages into a different language. [TETT, Abstract].

While TETT clearly performs the task of expanding abbreviated words in a wireless text message into full-text versions of those words, as shown above, nowhere does TETT teach or suggest replacing a name retrieved from a management data definition with a qualifier value. TETT teaches the expansion of abbreviated *wireless text messages*, not names that are retrieved from a management data definition, as recited in Applicants' claims.

Further, TETT does not teach replacing the text of such messages with *qualifier values*, as recited in Applicants' claims, either. TETT teaches replacing abbreviations with the full-text equivalents of those abbreviations. Applicants respectfully submit that the Examiner has not met his *prima facie* burden of demonstrating how the full-text expansions of abbreviated words in a wireless message constitute *qualifier values*.

Moreover, the TETT wireless messages are not *retrieved*, as in the presently claimed invention. TETT's wireless receiver passively receives messages from wireless transmitters and does not actively seek out and retrieve information. Thus, Applicants fail to see, even under the broadest reasonable interpretation of Applicants' claims, how TETT could be construed as teaching or suggesting Applicants' claimed feature of replacing a *retrieved name*.

C. The prior art must provide some motivation or incentive to combine the references so as to achieve the claimed invention

A proper *prima facie* case of obviousness cannot be established by combining the teachings of the prior art absent some teaching, incentive, or suggestion supporting the combination. *In re*

## PATENT

*Napier*, 55 F.3d 610, 613, 34 U.S.P.Q.2d 1782, 1784 (Fed. Cir. 1995); *In re Bond*, 910 F.2d 831, 834, 15 U.S.P.Q.2d 1566, 1568 (Fed. Cir. 1990).

In this case, the Examiner argues that TETT provides suitable motivation in that "One of ordinary skill would have been motivated to provide a string in the native language of a user (TETT column 2 lines 22-24) so that a user would be able to easily understand it." While the Examiner is certainly correct that allowing a user to view wireless messages translated into the user's native language is one of the benefits of TETT, the problem with the Examiner's argument is that it still does not demonstrate that one of ordinary skill in the art would have a motivation or incentive *to combine* that teaching of TETT with the features of Sun WBEM. The Examiner's argument illustrates why someone would want to apply the teachings of TETT to the problem addressed in TETT, namely wireless text messaging. It does not, however, provide any explanation as to how or why someone of ordinary skill in the art would be motivated by the prior art to apply those teachings to the technology of Sun WBEM, which has nothing to do with wireless text messaging.

Moreover, the Examiner's assumption that TETT's teachings apply in "an analogous environment" simply does not hold. Sun WBEM describes a tool for software development. TETT, as mentioned before, is directed to a system for wireless text messaging. If some analogy can be made between these two environments, Applicants are not aware of what that analogy may be and respectfully submit that it is the Examiner's burden to demonstrate such an analogy, if, in fact, such an analogy can be made.

Further, in determining obviousness, an applicant's teachings may not be read into the prior art. *Panduit Corp. v. Denison Mfg. Co.*, 810 F.2d 1561, 1575 n. 29, 1 U.S.P.Q. 1593, 1602 n. 29 (Fed. Cir. 1987) (citing need to "guard against hindsight and the temptation to read the inventor's teachings into the prior art"). A determination of the desirability of combining prior art references must be made without the benefit of hindsight afforded by an applicant's disclosure. *In re Paulsen*, 30 F.3d 1475, 1482, 31 U.S.P.Q. 1671, 1676 (Fed. Cir. 1994).

It appears that the Examiner is perhaps reading some of the teachings of Applicants' invention concerning the desirability of providing information in a user's preferred natural language into the prior art. Applicants' specification describes this benefit in the following excerpt:

If the element is an instance element then, in the same way that a qualifier was used for the non-instance element, a qualifier, such as "DisplayName"

Docket No. RSW920010051US1

Page 17 of 19  
Barker et al. - 10/047,784

Atty Ref. No. IBM-R111

**PATENT**

is may be used to specify the element name. In addition, a translated version of the element name may also be retrieved corresponding to the user's preferred language. [p. 5, lines 15-20].

While Applicants agree that this is a benefit of Applicants' invention that would be a desirable feature in a software development/object modeling tool such as Sun WBEM, the mere fact that we can recognize this benefit in hindsight, does not mean that a motivation or incentive for that teaching existed in the prior art. In this case, the Examiner has identified nothing from Sun WBEM to suggest the desirability of such a feature in Sun WBEM and has likewise identified nothing in TETT to suggest the desirability of applying the abbreviation expansion/translation concept in TETT to the wholly unrelated field of software development tools.

Therefore, Applicants respectfully submit that independent claims 1, 8, 15, and 22-25, as well as their respective dependent claims, claims 2-7, 9-14, 16, and 18-21, are patentable over the prior art of record. Applicants respectfully request that the rejection of those claims be withdrawn.

**V. Newly added claims 26-28**

Applicants have added new independent claims, 26 and 28, and a corresponding dependent claim 27. Applicants respectfully submit that these newly added claims are patentable over the cited references for at least the reasons set forth above with respect to the already-existing claims in the application. Further, Applicants respectfully submit that these claims include additional features not taught or suggested by the cited references. For instance, independent claims 26 and 28 recite constructing a display name from one or more non-propagated key properties, which is neither taught nor suggested by the cited references. Applicants therefore respectfully request allowance of claims 26-28.

**VI. Conclusion**

As a result of the foregoing, it is asserted by Applicants that the remaining claims in the Application are in condition for allowance, and Applicants respectfully request allowance of such claims.

Docket No. RSW920010051US1

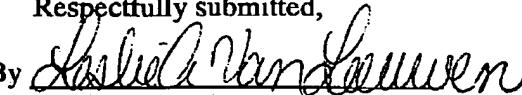
Page 18 of 19  
Barker et al. - 10/047,784

Atty Ref. No. IBM-R111

## PATENT

Applicants respectfully request that the Examiner contact the Applicants' attorney listed below if the Examiner believes that such a discussion would be helpful in resolving any remaining questions or issues related to this Application.

Respectfully submitted,

By 

Leslie A. Van Leeuwen  
Attorney for Applicants  
Registration No. 42,196  
Telephone: (512) 301-6738  
Facsimile: (512) 301-6742

Docket No. RSW920010051US1

Page 19 of 19  
Barker et al. - 10/047,784

Atty Ref. No. IBM-R111